

REMARKS

Applicants thank the Examiner for acknowledging the receipt of Response to Restriction Requirement filed on June 17, 2005 in which Applicants elected without traverse claims 1-9, 16-27, 32 and 33.

Applicants cancel claims 10-15 and 28-31 subsequent to electing claim Group I (*i.e.*, claims 1-9, 16-27, 32 and 33), as stated in the Response to Restriction Requirement filed on June 17, 2005. Therefore, claims 1-9, 16-27, 32 and 33 are all the claims currently pending in the present application.

Favorable reconsideration and withdrawal of rejections are respectfully requested.

Preliminary Matter

Applicants note that the Examiner's 35 U.S.C. § 103 (a) rejections on claims 1-3, 8, 9, 17, 23, 33 are based on a superseded claim language prior to the amendments made under 37 C.F.R. § 1.111 on December 29, 2004 (See Office Action: page 5). Applicants respectfully request that the Examiner fully consider and enter in the amendments made according to the Amendment filed under 37 C.F.R. § 1.111 on December 29, 2004.

Objection to Information Disclosure Statement (IDS)

Applicants thank the Examiner for discussing the IDS matter with Applicants' representative on October 12, 2005 over the telephone. On page 7 of the Office Action, the Examiner stated that he "did not receive the English translation of the corresponding documents"

for the three Japanese references listed on form PTO/SB/08 A&B¹ (Japanese Unexamined Patent Application Publication No. H07-087568, Japanese Unexamined Patent Application No. 2001-008271, and Japanese Unexamined Patent Application No. 2002-218535).

However, during the telephone conversation of October 12, 2005, the Examiner clearly indicated that an English language translation of those portions of a Japanese Patent Office Action (dated January 9, 2004) citing the Japanese references *is* in receipt.

As stated during the telephone conversation, Applicants respectfully submit that the requirement for a concise explanation of relevance is fully met by providing an English language translation of those portions of a corresponding Japanese Patent Office Action citing the three Japanese references.

MPEP clearly supports Applicants' position in this matter. MPEP § 609 (A) (3) unambiguously states:

Where the information listed is not in the English language, but was cited in a search report or other action by a *foreign patent office* [emphasis added] in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by *submitting an English language version of the search report* [emphasis added] or action which indicates the degree of relevance found by the foreign office. (*Id.*)

Therefore, Applicants respectfully request that the Examiner return an initialed form PTO/SB/08 A&B (enclosed herewith for the Examiner's convenience, along with a copy of the English language translation of those portions of Japanese Patent Office Action citing the three Japanese references).

¹ Submitted originally on December 29, 2004, then subsequently on April 7, 2004.

Rejection under 35 U.S.C. § 102(e) - Claim 16

Claim 16 is rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Havinis et al. (U.S. Patent No. 6,463,289; “Havinis”). Claim 16 is also rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Andersson et al. (U.S. Patent No. 6,230,017; “Andersson”). Applicants respectfully traverse the rejections based on the following remarks.

Claim 16 recites, *inter alia*, “limiting communications of a user terminal when said user terminal is *within a use prohibition area* where communications of said user terminal is not allowed, the prohibition area being a *portion of a cell zone*.” The Examiner alleges col. 4, lines 48-60 of Andersson discloses the noted feature of claim 16 (See Office Action: page 4). Applicants respectfully disagree.

The restriction of geographical area described in Andersson is made up of individual *cells in their entirety*, and therefore, there is no disclosure of “prohibition area where communications of said user terminal is not allowed, the prohibition area being a *portion of a cell zone*,” as recited in claim 16 (See Andersson: col. 2, lines 26-39, “In accordance with one mode of the invention, the mobile station is permitted to operate *only in cells identified* [emphasis added] in the subscriber’s record in the HLR.”; col. 4, lines 56-61, “e.g., the service is restricted to *one or more allowed cells* [emphasis added].”). In sharp contrast, claim 16 plainly recites that communications of a user terminal is limited “when said user terminal is within a use prohibition area ... the prohibition area being a *portion of a cell zone*.” Therefore, Applicants’ invention is unambiguously distinguishable from Andersson in that even a part and a portion of a cell zone can be set as a “prohibition area where communications of said user terminal is not allowed.”

In view of the foregoing, Applicants respectfully submit that Andersson fails to anticipate claim 16. Consequently, claims 17-21 are patentable over Andersson at least by the virtue of their dependency from independent claim 16.

The Examiner also rejected claim 16 under 35 U.S.C. § 102 (e) as allegedly being anticipated by Havinis. The Examiner alleges that col. 3, lines 45-46 of Havinis discloses claim 16. Applicants respectfully disagree.

Havinis simply fails to disclose the step of “*limiting communications* of a user terminal when said user terminal is within a use prohibition area where *communications* of said user terminal is not allowed,” as recited in claim 16. Rather, Havinis merely restricts *positioning* of a mobile subscriber within a specific geographical area (See Havinis: col. 3, lines 56-61). Therefore, even after restriction of positioning is placed on a mobile subscriber, it is still possible for the subscriber to *communicate* with other subscribers. Since Havinis only describes restricting *positioning* of a mobile subscriber, Applicants respectfully submit that Havinis fails to disclose the step of “*limiting communications* of a user terminal,” as described in claim 16 (See Havinis: col. 4, lines 64-67).

In view of the foregoing, Applicants respectfully submit that Havinis fails to anticipate claim 16. Consequently, claims 17-21 are patentable over Havinis at least by the virtue of their dependency from independent claim 16.

Rejection under 35 U.S.C. § 102(e) - Claim 22

Claim 22 is rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Havinis.
Claim 22 is also rejected under 35 U.S.C. 102(e) as allegedly being anticipated by Andersson.

The Examiner asserts that Andersson teaches “a communication control program” recited in claim 22 (See Office Action: page 4). Applicants respectfully disagrees.

Andersson simply fails to disclose “a communication control *program* that controls mobile communications of a user terminal by controlling a *computer*,” as recited in claim 22. The Examiner’s citation of col. 4, lines 48-60 merely describes a Home Location Register (HLR) used to store and manage subscription information for mobile subscribers. (See Andersson: col. 1, lines 36-38). An HLR may store data about subscribers such as subscriber’s MSITDN, IMSI, supplementary services and restriction information for limiting the subscriber’s use of the mobile station to a specified geographical area. (See Andersson, col. 4, lines 48-51; col. 5, lines 16-24). However, the HLR does not disclose “a communication control program that controls mobile communications of a user terminal by controlling a computer.” In fact, Andersson is entirely silent on the matter of a “*program... controlling a computer, said program executing a process of limiting communications of a user terminal in accordance with a location of said user terminal,*” as recited in claim 22.

In view of the foregoing, Applicants respectfully submit that Andersson fails to anticipate claim 22. Consequently, claims 23-27 are patentable over Andersson at least by the virtue of their dependency from independent claim 22.

Claim 22 is also rejected under 35 U.S.C. § 102 (e) as allegedly being anticipated by Havinis. Applicants respectfully traverse the rejection.

Since claim 22 recites features (i.e., “*limiting communications* of a user terminal”) that are similar to the features recited in claim 16, Applicants respectfully submit that claim 22 is patentable over Havinis at least under the rationale discussed above for claim 16.

Furthermore, Applicants respectfully submit that Havinis fails to disclose a “communication control *program*... controlling a *computer*, said program executing a process of limiting communications of a user terminal in accordance with a location of said user terminal,” as recited in claim 22.

In view of the foregoing, Applicants respectfully submit that Havinis fails to disclose claim 22. Consequently, claims 23-27 are patentable over Havinis at least by the virtue of their dependency from independent claim 22.

Rejections under 35 U.S.C. § 103(a)

Claims 1-3, 8, 9, 17, 23, 33 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Havinis in view of Hameleers et al. (U.S Patent No. 6,377,799; “Hameleers”).

Claim 1 recites, *inter alia*, “a communication limiter... wherein said limiter transmits disconnect instructions to said user terminal when said user terminal is within said *prohibition area*.” The Examiner acknowledges that Havinis fails to teach the noted features of claim 1 (See Office Action: page 5). However, the Examiner asserts that such features are disclosed in column 4, lines 43-44 of Hameleers (See Office Action, page 5). Applicants respectfully disagree.

With regard to an obviousness rejection, MPEP § 2143.03 states:

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Applicants respectfully submit that Hameleers fails to disclose “a communication limiter... wherein said limiter transmits disconnect instructions to said user terminal when said user terminal is within said *prohibition area*,” as recited in claim 1.

The disconnect message 53 cited by the Examiner which originates from MSC/VLR 15 is sent during “a release sequence when concluding the mobile-originated data or fax call of FIG. 1A” (See Hameleers: col. 4, lines 37-39). Such sending of the disconnect message² occurs during an ordinary course of concluding a call, and therefore, is not sent “when said user terminal is within said prohibition area,” as recited in claim 1 (See Hameleers: col. 4, lines 36-51).

Hameleers is pertinent to the field of Internet Protocol (IP)-based Global System for Mobile Communications (GSM) radio telecommunications network (See Hameleers: col. 1, lines 10-12). In general, Hameleers describes how the data services in an IP-based radio telecommunications are provided through implementing an Internet protocol Shared Interworking Function (IP-SIWF) (See Hameleers: col. 1, lines 50-54). However, such mode of operation

² The only disconnection described in Hameleers is performed during the ordinary course of terminating the radio access and radio link protocols, and is fundamentally different from the operation of “a communication limiter” recited in claim 1 (See Hameleers: col. 2, lines 2-6, “The IP-SIWF includes means for terminating the radio access and radio link protocols and transporting the data payload thereafter utilizing a real time protocol over a UDP and an IP protocol layer.”).

described in Hameleers is fundamentally different from that of claim 1, and at the very least, Hameleers fails to disclose "a communication limiter ... wherein said limiter transmits disconnect instructions to said user terminal when said user terminal is within said *prohibition area*," as recited in claim 1.

In view of the foregoing, Applicants respectfully submit that independent claim 1 is patentable over Havinis in view of Hameleers. Consequently, claims 2-9, 32 and 33 are patentable at least by the virtue of their dependency from independent claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Daniel Wooseob Shim
Registration No. 56,995

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: December 6, 2005